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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/684,856	10/13/2003	Ronald Highsmith	H0001324 - 4690	3520
23639	7590	06/28/2006	EXAMINER	
BINGHAM, MCCUTCHEN LLP THREE EMBARCADERO CENTER 18 FLOOR SAN FRANCISCO, CA 94111-4067			LE, HOA T	
			ART UNIT	PAPER NUMBER
			1773	

DATE MAILED: 06/28/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No.	Applicant(s)
	10/684,856	HIGHSIMTH, RONALD
	Examiner H. T. Le	Art Unit 1773

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) Responsive to communication(s) filed on 27 February 2006.
- 2a) This action is **FINAL**.                                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) Claim(s) 27-43 is/are pending in the application.
- 4a) Of the above claim(s) 38-43 is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 27-37 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All    b) Some \* c) None of:
  1. Certified copies of the priority documents have been received.
  2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)	4) <input type="checkbox"/> Interview Summary (PTO-413)
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	Paper No(s)/Mail Date. _____.
3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.	5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)
	6) <input type="checkbox"/> Other: _____.

## **DETAILED ACTION**

1. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

### ***Continued Examination Under 37 CFR 1.114***

2. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on February 27, 2006 has been entered.

### ***Election/Restrictions***

3. Newly submitted claims 38-43 are directed to an invention that is independent or distinct from claims 27-37, which is the invention originally claimed, because they are not related to each other. Claims 27-37 are directed to polyamide particles while claims 38-43 are directed to a reaction mixture and its product. The polyamide particles as recited in claims 27-37 can be made by condensation polymerization or melt polymerization, which process does not involve the reaction mixture of claims 38-40. Therefore, the invention of claims 38-40 are unrelated to the invention of claims 27-37.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for

prosecution on the merits. Accordingly, claims 38-43 withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 818.02(a) and § 821.03.

***Claim Rejections - 35 USC § 102***

**4. Claims 27-37 are rejected under 35 U.S.C. 102(b) as being anticipated by Okada (US 4,894,411).**

Claim 27: Okada teaches a polyamide-containing resin comprising particles having diameter of 1 micron or less (col. 5, lines 7-11).

Claim 28: -CONH is a generic acid amide bond in a polyamide (see col. 2, lines 49-51).

Claims 29-30: See col. 2, lines 50-52.

Claim 31: See col. 5, lines 7-11.

Claims 32-34: See abstract (last line).

Claims 35-37: See col. 2, last two lines; and col. 3, lines 23-32.

**5. Claims 27-37 are rejected under 35 U.S.C. 102(b) as being anticipated by Smith (US 5,407,985).**

Claim 27: Smith teaches a dispersion comprising a plurality of polyamide resin particles.

The particles have particle size of less than one micron. See col. 8, lines 19-25.

Claims 28-30: -CONH is a generic acid amide bond in a polyamide and nylon-6 is a trade name for polyamide (see for example, US pat. 4,894,411 to Okada at col. 2, lines 49-51).

Claim 31: See col. 8, lines 19-25.

Claims 32-34: Polyamide microparticles with particle size of less than one micron are disclosed to be transparent (col. 8, lines 10-25). Also, see abstract where the film formed from these polyamide microparticles is described to be “clear” which necessarily requires that the polyamide is transparent.

*Claim Rejections - 35 USC § 103*

6. **Claims 35-37 are rejected under 35 U.S.C. 103(a) as being unpatentable over Smith (US 5,407,985) as applied to claims 27-34 above, and further in view of Ogawa (US 5,139,760).\***

Smith teaches the claimed invention as discussed in section 4 above. Ogawa teaches the incorporation of alumina-silicate as fillers or pigments in polyamide in order to improve physical properties of the film containing the polyamide. See Ogawa, col. 7, lines 9-11. Therefore, it would have been obvious for one having ordinary skill in the art to incorporate alumina-silicate in polyamide-containing composition in order to provide color or strength to the composition as suggested by Ogawa.

7. **Claims 35-37 are rejected under 35 U.S.C. 103(a) as being unpatentable over Smith (US 5,407,985) as applied to claims 27-34 above, and further in view of the discussion below.**

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\* provided in a previous office action.

Incorporating additives including alumina silicate, nucleating agents and colorants into a polyamide resin is a common practice in the art in order to provide or improve various physical properties of the polyamide. See for examples: US Pat. 4,894,411 (Okada et al) at col. 2, last two lines and col. 3, lines 23-32; US Pat. 4,387,184 (Coquard et al) at col. 6, lines 60-63; US Pat. 4,726,989 (Mrozinski) at col. 7, lines 37-40; US Pat. 6,127,513 (Ohara et al) at col. 4, lines 31-38. Therefore, it would have been obvious for one having ordinary skill in the art to incorporate additives including nucleating agent, alumina-silicate or colorant in polyamide-containing composition in order to provide or enhance various physical properties including color or strength to the polyamide composition.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to H. T. Le whose telephone number is 571-272-1511. The examiner can normally be reached on 10:00 a.m. to 6:30 p.m., Mondays to Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Carol Chaney can be reached on 571-272-1284. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



H. T. Le  
Primary Examiner  
Art Unit 1773

June 23, 2006